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EXAMINER
MCDONALD, C

B4M1/1114

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN
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ART UNIT	PAPER NUMBER
2401	4

DATE MAILED: 11/14/94

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 8/22/94 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), ___ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice re Patent Drawing, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, Form PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____

Part II SUMMARY OF ACTION

1. ☒ Claims 1-11, 15, 16 are pending in the application.
   Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1-11, 15, 16 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).
12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____ ; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

PTOL-326 (Rev. 9-89)

1. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

2. Claims 1,2,4,5,9,10 and 16 are rejected under 35 U.S.C. § 103 as being unpatentable over Gerber in view of Miller.

Gerber discloses a golf bag with a removable compartment. Gerber does not disclose a compartment that is attached by a circumfrential zipper. Miller discloses a compartment that can be added to a bag that is attached by a circumfrential zipper. It would have been obvious to use a panel with a circumfrential zipper to make the compartment of Gerber motivated by Miller's teaching of the ease in adding and removing the compartment.

3. Claims 3 and 7 are rejected under 35 U.S.C. § 103 as being unpatentable over the prior art as applied to claims 1,2,4,5,9,10 and 16 above, and further in view of Setani.

The combination does not disclose the use of a carrying strap diametrically opposed to the pockets. Setani discloses the use of a shoulder strap(4) diametrically opposed to the pockets(13). It would ahve been obvious to use a shoulder strap diametrically opposed to the pockets of Gerber motivated by Setani's teaching of the ease in carrying a bag that has a shoulder strap.

4. Claims 6,8 and 15 are rejected under 35 U.S.C. § 103 as being unpatentable over the prior art as applied to claims 1,2,4,5,9,10 and 16 above, and further in view of Yamazoe.

Gerber discloses the invention as claimed except for the use of a water resistant and padded material. Yamazoe discloses a golf bag which has pockets made from a waterproof material and padding (see fig. 5). It would have been obvious to use waterproof material and padding with the pockets of Gerber motivated by Yamazoe's teaching of the protection the material gives to the pocket's contents.

5. Claim 11 is rejected under 35 U.S.C. § 103 as being unpatentable over the prior art as applied to claims 1,2,4,5,9,10 and 16 above, and further in view of Brown.

The combination does not disclose the use of a lateral opening in the compartment. Brown discloses removable compartments for a golf bag that have lateral openings. It would have been obvious to use lateral openings with the compartments

of Gerber motivated by Brown teaching of the easy access to the compartment's contents.

6. Applicant's arguments filed Aug. 22, 1994 have been fully considered but they are not deemed to be persuasive.

In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgement on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. *In re McLaughlin*, 443 F.2d 1392; 170 USPQ 209 (CCPA 1971). In this case, the teaching references shows a different type of removable compartment that can used to modify the one being used by the principal reference.

In response to Applicant's argument that the invention allows the application of indicia, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

7. Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL.** See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chris McDonald whose telephone number is (703) 308-1038.

ALLAN N. SHOAP
SUPERVISORY PATENT EXAMINER

CJM
November 8, 1994

ALLAN N. SHOAP
SUPERVISORY PATENT EXAMINER
GROUP 2400